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Docket Number (Optional)

115274-008

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on **September 15, 2005**

Signature

Typed or printed name

Heather Foster

Application Number

09/054,180

Filed

April 1, 1998

First Named Inventor

Brian J. Reistad et al.

Art Unit

3621

Examiner

Firmin Backer

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number **48,196**☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

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Telephone number

September 15, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Brian J. Reistad et al.
Appl. No.: 09/054,180
Conf. No.: 2217
Filed: April 1, 1998
Title: ELECTRONIC COMMERCE SYSTEM
Art Unit: 3621
Examiner: Firmin Backer
Docket No.: 0115274-0008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This request is submitted in response to the Final Office Action dated June 15, 2005. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

Remarks begin on page 2 of this paper.

REMARKS

The present request and remarks are submitted in response to the clear errors maintained in the Final Office Action mailed June 15, 2005. No amendments and no new matter are introduced by this paper. Claims 12-36 and 39-63 remain in this application. Of the pending claims, claims 12-14, 34-36, 39-41 and 61-63 are independent.

Claims 12-36 and 39-63 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Candelore* (US Patent 6,057,872) in view of *Civanlar* (US Patent 6,005,935). Applicant traverses these rejections. Favorable reconsideration is respectfully requested.

Applicants respectfully submit that the pending Final Action does not provide a proper basis for establishing a *prima facie* case of obviousness, as none of the cited art, alone or in combination, disclose, among other things, a client computer configured for, or the step of, transmitting an order acceptance request over a packet-switched network that includes a plurality of modular elements, with each modular element individually protected by an imbedded cryptographic security code. Also among the features of the pending claims is a server configured to, or the step of, transmitting an order acceptance response to a client, the order acceptance response also including a plurality of modular elements whose individual integrity is protected by embedding a cryptographic security code within each modular element.

The communication system in *Candelore* teaches digital coupons for pay television, where TV service providers broadcast credit information in the form of "digital coupons" to individual subscriber terminals to promote particular programs and reward viewer loyalty (col. 1, lines 9-14). Further distinguishing details regarding the *Candelore* system were argued in the Response filed March 21, 2005 ("the Response") on page 17, 4th paragraph, and in the Appeal Brief dated September 7, 2004, pages 5-6.

Applicants reiterate the arguments contained in the Response, in that the Examiner erroneously interprets *Candelore's* communication channel 120 as teaching client and server computers connected by a public packet switched network.

Furthermore, even if the system of *Candelore* was interpreted as a packet-switched network, the data sent in connection with the coupons is configured for broadcast to a user or

groups of users from a central location. Accordingly, one consequence of this is that there is no connection among separate users. It follows that, under the exemplary claim features recited in claims 12-13 and 39 *Candelore* cannot teach a system “wherein the client computer is programmed to receive the digital coupon, protected by a cryptographic security code, from another computer” as recited in claims 12 and 39, or a system “wherein the digital coupon is configured to be used by any coupon holder that possesses the digital coupon, and wherein the server computer is programmed to accept the digital coupon without regard to the identity of the coupon holder” as recited in claim 13, since the broadcast of *Candelore* is explicitly targeted to identified set-top boxes.

Moreover, *Candelore* does not teach transmitting an order acceptance request/response comprising a plurality of terms and conditions of a proposed offer for a purchase, the order acceptance request including a plurality of modular elements whose individual integrity is protected by embedding cryptographic security codes in each modular element. The Office Action of December 17, 2004 has conceded this point.

In this regard, *Civanlar* was cited as a secondary reference for allegedly teaching a plurality of modular elements whose individual integrity is protected by embedding cryptographic security codes within each of the modular elements (col. 1, lines 46-55, col. 2, lines 6-45; col. 2, line 65-col. 3, line 40). However, this assertion misinterprets the teaching in *Civanlar*. The reference does not teach a “plurality of modular elements,” but merely discloses a system and method for embedding a security key onto a purchased product to prevent unauthorized access. In contrast to the present claims, *Civanlar* teaches the collection of “personalized information” to generate a single key that is attributable to the purchaser (col. 2, lines 36-50; see claim 1). Furthermore, the encryption system of *Civanlar* is completely removed from the user interaction with a server, as the reference clearly teaches that the encryption is performed regardless whether a product was purchased on-line, in a store, or even by mail (col. 2, lines 27-34).

Applicants also reiterate that the Final Office Action improperly combined the *Civanlar* and *Candelore* references by failing to consider the claim as a whole and furthermore relied on impermissible hindsight in formulating the rejection. There is no teaching or suggestion for one of ordinary skill in the art to combine the teaching of *Civanlar* with that of *Candelore* in the

manner suggested by the Examiner. As argued in the Response, *Candelore* teaches a broadcast system where EMM/ECM codes are used to control transmission of PPV broadcasts to a set-top box. In contrast, *Civanlar* teaches a manual encryption configuration in a non-analogous art, where purchases of products have encryption keys manually entered into their products for future use or access. Applicants respectfully submit that there is no teaching, suggestion or motivation for one skilled in the art to combine the disclosure of *Civanlar* with that of *Candelore*. In light of the EMM/ECM codes disclosed in *Candelore*, one skilled in the art would have no reason to turn to the teaching in *Civanlar*.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

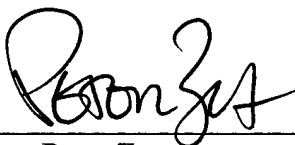
Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does

not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

In light of the above amendments and arguments, Applicants submit that the present patent application is in condition for allowance and request a Notice of Allowance be issued. A check in the amount of \$500 is submitted herewith to cover the large-entity fee for the Notice of Appeal set forth under 37 C.F.R. §41.31. The Commissioner is authorized to charge and credit Deposit Account No. 02-1818 for any additional fees associated with the submission of this Response. Please reference docket number 0115274-0008.

Respectfully submitted,

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Dated: September 15, 2005